



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,050	06/08/2001	Peter C. Boylan III	UV-197	1639
1473	7590	11/19/2003	EXAMINER	
FISH & NEAVE 1251 AVENUE OF THE AMERICAS 50TH FLOOR NEW YORK, NY 10020-1105			PAIK, STEVE S	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

10

Office Action Summary

Application No.

09/878,050

Applicant(s)

BOYLAN ET AL.

Examiner

Steven S. Paik

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 124-153 and 277-336 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 124-138, 277-291 and 307-336 is/are allowed.
- 6) ☒ Claim(s) 139-153, 292-306 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 30, 2003 has been entered.

Response to Amendment

2. Receipt is acknowledged of the Amendment filed October 14, 2003. The Amendment cancels claims 1-123 and 154-276.

Claim Objections

3. Claim 125 is objected to because of the following informalities: the limitation "the docking station" in line 3 lacks a proper antecedent basis. The Examiner respectfully suggests changing the limitation with -- a docking station --. Appropriate correction is required.

4. Claims 139-153 are objected to because of the following informalities: the limitation "the user" in line 5 on page 5 of the Amendment lacks a proper antecedent basis. The Examiner respectfully suggests changing the limitation with -- a user --. The dependent claims of Claim 139 are objected in accordance with their dependency. Appropriate correction is required.

5. Claims 140, 141, 293, and 294 are objected to because of the following informalities: the limitation "a user" in line 2 of each claim appears to be in a better form by changing the limitation as -- the user --. Appropriate correction is required.

6. Claims 278, 279, 308, 309, 323, and 324 are objected to because of the following informalities: the limitation "a user" in line 2 of each claim appears to be in a better form by changing the limitation as -- the user --. Furthermore, "the docking station" in claims 278, 308, and 323 lacks a proper antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 139, 142-144, 150-152, 292, 295-297, 303-305 are rejected under 35 U.S.C. 102(c) as being anticipated by Knowles (US 6,321,991).

Re claims 139, 150, 151, 292, 303 and 304, Knowles discloses a method and system for using a portable scanning device (wireless barcode reading device 7A) for allowing a user to acquire information associated with codes comprising:

scanning a code (URL-encoded barcode symbol 8) using a portable device wherein the portable device (7A) comprises code scanning equipment;

acquiring information associated with the scanned code (col. 7, line 1 – col. 9, line 42);
and

presenting the information to the user in a language determined by the user (Abstract; Once a user makes a connection to a particular website via the URL- encoded barcode symbol, the user may access the contents of the site in accordance with his/her preferred language. The

web browsers in the market provides such an option to the Internet users), wherein the language is determined by the user after the code is scanned (The language selection process definitely occurs after scanning and accessing the barcode. Furthermore, the user may select more than one language of his/her choices).

Re claims 142 and 295, Knowles discloses the method and system as recited in rejected claims 139 and 292 stated above respectively, wherein the information is acquired via a wireless path (wireless portable barcode symbol reading system 7A)

Re claims 143 and 296, Knowles discloses the method and system as recited in rejected claims 142 and 295 stated above respectively, wherein the wireless path is an infrared path (col. 8, ll. 13-31).

Re claims 144 and 297, Knowles discloses the method and system as recited in rejected claims 142 and 295 stated above respectively, wherein the wireless path is a radio frequency path (col. 3, ll. 57-65).

Re claims 152 and 305, Knowles discloses the method and system as recited in rejected claims 139 and 292 stated above respectively, wherein the code is scanned from printed material (col. 2, ll. 51-58).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 140, 141, 147, 148, 153, 293, 294, 300, 301, and 306 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knowles (US 6,321,991) in view of Nelson (US 5,939,695).

Knowles discloses a wireless portable barcode scanner that reads URL-encoded barcodes and provides connections to the Internet terminal unit. The acquired barcode information can be presented in a language of the user's choice and accesses an audio-visual monitor of a television set for viewing purposes.

However, Knowles does not disclose about a docking station and an output device at the portable device.

Nelson discloses a step of presenting the acquiring information to a user at a docking station (75 and col. 3, lines 28-37 which allows a different PCS to communicate with the base system; see Fig. 4) via an output device at the docking station (col. 3, ll. 33-37 of Nelson) and the step of presenting the acquired information to a user at the portable device (3) via an output device (6) at the portable device. Furthermore, Nelson's docking system is connected by connecting hardware such as a computer in a wired manner. The barcode information scanned from a barcode by a barcode scanner of Nelson can be transmitted to another portable barcode scanning device via the docking station using a wired or a wireless communication protocol.)

Nelson's teaching provides more simultaneous access to multiple users and a way to track each who's using which portable device in combination of a wireless and a wired communication link.

In view of Nelson, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ a plurality of portable information reading devices in addition to the singular wireless portable barcode reading device of Knowles due to

the fact that more data can be simultaneously but separately acquired for the purposes of increasing usability. Furthermore, such modification of employing a plurality of portable information reading device to the teachings of Knowles would have been an obvious matter of design variation, well within the ordinary skill in the art, and therefore an obvious expedient.

11. Claims 145, 146, 298, and 299 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knowles (US 6,321,991) in view of Ruppert et al. (US 5,640,02).

The teachings of Knowles have been discussed above. Knowles discloses all of the features of the claimed invention with the exception of specifically disclosing a particular type of a wireless path and practical application of a portable personal scanner (Fig. 1).

Ruppert et al. disclose another type of wireless communication links used in data communication. Some information on infrared and radio wireless data transmission is publicly available through the IEEE 802.11 Wireless Networking Work Group. Furthermore, he teaches that the particular data communication interface and port are not critical to the invention, and selection of what type port to use depends upon the desired mode of operation for the device (col. 9, lines 50-55). He further discloses steps of building and modifying a shopping list using a scanner reading coded information on a product or good with the capability of alerting a price of a product (col. 7, lines 41-50).

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have incorporated any one of available data communication protocols and a personal scanner using the protocols to generate and modify a list as taught by Ruppert et al. into the teachings of Knowles for the purpose of allowing design flexibility and maximizing the efficiency of acquiring information process since it is an obvious matter of

design choice well within the art and providing more options and assistance to the user when shopping.

12. Claims 149 and 302 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knowles (US 6,321,991) as modified by Nelson (5,939,695) as applied to rejected claims stated above, and further in view of Allport. (US 6,097,441).

The teachings of Knowles in view of Nelson have been discussed above. Knowles in view of Nelson discloses all of the features of the claimed invention with the exception of specifically disclosing a particular type of a wired path.

Allport discloses a wired communication link using Firewire 1394 protocol wired communication between a hand-held remote control and a base station (col. 19, lines 12-15, claim 35). A Firewire is one of many available wired data communication protocols, which may be selected by a network designer in accordance with specifications, and cost of building a network.

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have incorporated any one of available wired data communication protocols as taught by Allport into the teachings of Knowles in view of Nelson for the purpose of allowing design flexibility and maximizing the efficiency of acquiring information process since it is an obvious matter of design choice well within the art.

Allowable Subject Matter

13. Claims 124-138, 277-291, and 307-336 are allowable.

The following is a statement of reasons for the indication of allowable subject matter: none of the cited prior arts discloses, teaches, or fairly suggests the claimed method and system

of acquiring coded information by a portable reading device. The acquired information further comprises an upcoming schedule of use of an equipment or facility associated with the code and scheduling the use of the equipment or facility. Previously cited references (Ueda et al. (US 4,866,258), Knowlcs (US 6,321,991) discloses a step of reading a barcode and programming a recording process of TV program. However, the cited references do not teach or disclose the claimed step of acquired information comprising an upcoming schedule of use of an equipment or facility and scheduling the said equipment or facility.

Response to Arguments

14. Applicant's arguments, see pages 17-23, filed October 14, 2003, with respect to claims 124-138, 277-291, and 307-336 have been fully considered and are persuasive. The claims are now allowable.

15. Applicant's arguments filed October 14, 2003 with respect claims 139-153 and 292-306 have been fully considered but they are not persuasive.

After fully considering the Applicant's argument and reviewing the pending claims, the Examiner believes the cited prior arts taken alone or in combination of other reference read on the claims 124-138, 277-291, and 307-336.

Accordingly, claims 124-138, 277-291, and 307-336 remain rejected.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 703-308-6190. The examiner can normally be reached on Mon - Fri (5:30am-2:00pm).

Application/Control Number: 09/878,050
Art Unit: 2876

Page 9

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0530.

Steven S. Paik
Steven S. Paik
Examiner
Art Unit 2876

ssp
November 14, 2003